

REMARKS

In the June 30th Office Action, the Examiner indicated that the finality of the last office action was withdrawn, but that Applicant's previous arguments "are moot in view of the new ground(s) of rejection."

The only new prior art reference that has been applied in this Office Action that has not been applied in previous Office Actions is Needler. All other applied references have been previously cited and, as previously explained, and explained again below, are irrelevant to the claimed inventions.

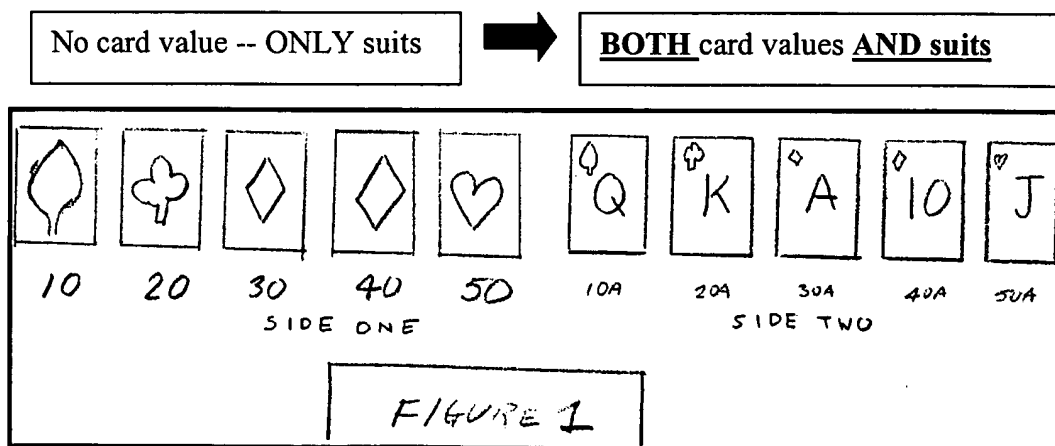
The Examiner continues to overlook the fundamental difference between the inventions and the prior art -- the card's suit (heart, diamond, etc.) and the card's value (i.e., ace, 10, queen, etc.) are **SEPARATED** when the card is first dealt. No other card has this novel property. It is also important to understand that the term "card value" relates exclusively to the cards' rank in the deck: 2, 3, 4, 5 . . . to Jack, Queen, King, Ace. A numeral "2," that denotes a particular group of cards, like in Silliman, is not a card value as used in Applicant's invention.

The second novel property of the cards of this invention is that they **CHANGE** their appearance as the game is played from providing partial information about the card (i.e., the suit alone) to providing complete information about the card (i.e., both the card's suit and the card's value). Applicant's cards when first dealt show **ONLY** the suit -- and not the card value. No other card has this property. When the player selects the card, the appearance of the card **CHANGES** to show **BOTH** the suit and card value.

No other card in the prior art has these properties and no prior reference suggests these properties. All claims include this innovation, and new claims 30 and 31 explicitly spell out that the appearance changes.

It bears repeating all other prior art cards are static -- that is, they do not change as they are played, they have a front, which shows the suit AND the card value, and a back (which has NO INFORMATION ABOUT THE CARD'S SUIT OR THE CARD'S VALUE).

Applicant's Figure 1 (reproduced below) shows the dynamic change of his invention. When the cards are first dealt they display only the suit. This is shown on the left side of the figure above "Side One." When the player selects the cards, the cards change their appearance. This is shown on the right side of the figure (side two) where both the card's suit and the card's value are displayed. The Examiner is urged to compare the two sides shown in Figure 1 to see the fundamental difference between the appearance. Side one has no card value. Side two has both the card value and the suit.



This significant, and completely unique distinction alone is enough to separate the prior art from the claimed inventions.

As explained in the MPEP 2001.06, Applicant points out to the Examiner that the Applicant has several co-pending applications in same general art: 10/015,314, 10/211,063 and 10/418,829 (Collins, Examiner).

Abstract

The abstract has been amended to explain more clearly the invention and to correspond more precisely to the Figures. No new matter has been added because the amendment explains precisely what has been in the Figures since the filing date.

Specification

The specification has been amended to explain more clearly the invention, to correspond more precisely to the Figures and to correct for some typographical errors. No new matter has been added because the amendment explains precisely what has been in the Figures since the filing date.

Claim 1 - Section 35 USC § 102

Claim 1 was rejected under 35 USC § 102(b) as allegedly being anticipated by Needler. The Examiner stated: "Needler teaches cards that display a suit on one side (e.g. clubs) and both a suit and value on the other side." Applicant respectfully disagrees with Examiner's conclusion.

Needler

Needler's patent is a design patent that is described in his claim as "the ornamental design for a playing card." Design patents protect only ornamental features. 35 U.S.C. § 171 and MPEP ¶ 1504.01(c). Thus, Needler's design cannot affect the function of the cards.

Needler -- like virtually all prior art references -- has a non-descriptive or decorative (i.e., ornamental) back so that the cards can be dealt face down. Needler chose to use a design that looks like a club pattern. However, that pattern is not related to the card's suit, which is shown on the reverse side of Needler's cards. The Examiner is requested to look at Needler Figure 2 -- that shows the card is an Ace of Spades. Thus, the design on Needler's card back is completely irrelevant to the card's suit. The design is a club -- but the card shown is a spade.

Moreover, Needler's ornamental design (which admittedly looks like a club) is the same for all 52 cards in the deck regardless of what the card's suit is. No person of ordinary skill in the art would equate the design on Needler with the card's suit. (See Declaration of Jon Hafezi. ¶ 7 accompanying this response "Hafezi Dec.")

Needler is a conventional playing card that has a non-descriptive back with a design that happens to look like a club. Unlike Applicant's cards -- Needler's cards do not change their appearance -- and Needler's cards do not SEPARATE the card's suit and the card's value. In Needler, the card's suit (spade) and card's value (Ace) ARE BOTH ON THE SAME SIDE OF THE CARD, and appear only together. In the claimed invention, the player must compare the likelihood of all possible payouts of all the potential hands in Hand A (royal flush, flush and straight) to the certain payout for

three of a kind. The player, therefore must decide between the possibility of one or more higher payouts in Hand A and the sure payout for three of a kind in Hand B. The payouts are indicated in the specific payable for the game. as shown in Needler's Figure 2.

As previously explained, Applicant's Claim 1, as shown in Applicant's Figure 1, requires that when the card is first dealt "it displays the card's suit but not the card's value[.]" Claim 1 has been amended to even more clearly state that the card's suit must be displayed. Any arbitrary suit is insufficient. Needler does not, and cannot, display the card's suit separately from the card's value. Both are ALWAYS displayed together.

Applicant's Figure 1 shows that the side of the card with only the suit showing has a one-to-one correspondence with the suit of the playing card. See Figure 1 10 (left side) and 10A (right side), 20 and 20A, etc. That is, card 10 when first dealt shows a spade. When the player selects it, it remains a spade and the card value, a queen, is also displayed (see Figure 1 above 10A).

Applicant's invention directly affects how card games are played and allows the invention of many new games that have never been played before because the novel cards simply did not exist. Many games using these cards are described in Applicant's co-pending application 10/418,829 (for which Examiner Collins is also the Examiner of record).

These new games are available because when the player is dealt a card that shows him the suit, he has essentially half the information about the card. When a conventional card is dealt face down, the player has no information about the card and the player's decision to select the card or not is basically guesswork.

Conventional cards -- like Needler -- are an all or nothing proposition. In Needler when the card is dealt face down a player has no information about the card. When the card is turned over the player has all the information about the card (i.e., both the suit and card value). So, Needler goes from zero information to complete information.

The differences between Needler and the Applicant's invention are stark, direct and overwhelming. Needler has nothing whatsoever to do with the Applicant's invention.

Claim 2

Examiner has rejected claim 2 as being "unpatentable over Needler, in view of Hoyt, et al."

Applicant believes that for the reasons stated above, Needler does not, as Examiner has stated, "teach a suit on one side and a suit and a value on the other." Needler's card does not disclose the card's suit: it shows an arbitrary design that happens to look like a club. No person of ordinary skill in the art would equate the design on Needler with a suit (Hafezi Dec. ¶ 7).

Similarly, Hoyt does not have the claim element: "the cards have the card's suit on one side but not the card's value and both the card's suit and card's value on the other[.]"

Moreover, Hoyt does not teach "some cards are standard cards with non-descriptive backs."

Hoyt's Abstract states: "each card having a back side which is similar to each of the other playing cards such that the cards cannot be distinguished by observing the back side."

There is no mention in Hoyt of any card back, other than conventional, anywhere in Hoyt's patent. Hoyt relates solely to the "front side" of the playing cards. (Hafezi Dec. ¶ 9). Plainly, Hoyt's cards are not the same or remotely similar to Applicant's novel deck.

Even if these references would have been combined by a person of ordinary skill in the art, they would still not result in the claimed invention, (Hafezi Dec. ¶ 12) and the combination cannot be said to have demonstrated obviousness. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP § 2143.03 (emphasis added).

Claims 3 and 5

The Examiner stated:

"Stanton discloses Improvements in and relating to Playing cards. Stanton teaches cards with [sic, indicia(?)] arranged into four suits on one side and values on the other side (page 1, lines 14-24 & figures 1-4).

It would be obvious in view of Stanton to arrange the card[s] to add excitement to the game played by the players."

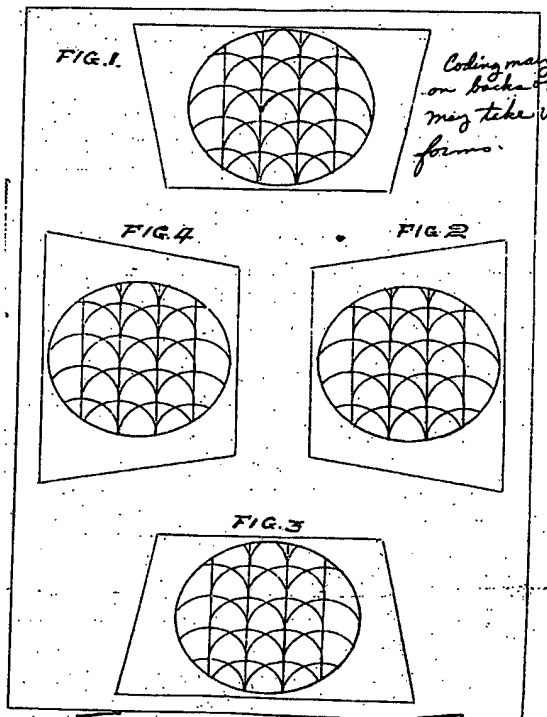
For clarity, Applicant has reproduced Stanton lines 14 to 24 to demonstrate that nothing in Stanton describes or suggests using card values, or the card's suit on the card backs:

“According to this invention, I arrange the complete set of cards, *i.e.*, the four suits, into four sets each set having cards of equal value, and so mark, print, brand, denote or otherwise or otherwise distinguish the four sets that, in dealing, each player will receive one of the sets of cards. The distinguishing of the cards may be variously modified as desired, it may be done by printing the backs of the cards in different colours, by applying distinguishable advertisements, or by printing different designs, one on each set.

In arranging say, an ordinary set or pack of playing cards each distinctive set will consist of the following cards; *viz*: Ace, ten, six and two (deuce) of one suit ; king, nine and five of another suit; queen, eight and four of another suit, and knave, seven and three of the last suit. (Emphasis added).”

1. This passage does NOT mention anywhere, that a value, of any type, is printed on the card backs. There is no Figure in Stanton that shows cards backs with any value printed on them. The Stanton patent’s reference to card backs is unlike the pending application because it affects the distribution of cards prior to the start of a game and is not related to the suit or card value of individual cards. (Hafezi Dec. ¶ 8).

Furthermore, Stanton does not separate the card’s suit from the card’s value. Moreover, the appearance of Stanton’s cards does not change (other than from a face down to a face-up card).



Stanton's Figures are at the left. The Examiner states that they show "four suits on one side and values on the other side." These Figures show neither suit nor card values (or values of any kind). The Examiner's conclusion, therefore, is wrong. Stanton simply does not separate the card's suit from the card's value, and neither suit nor value is displayed separate on the card back.

Stanton's cards, therefore, do not display the suit alone and do not have the claim limitation: "the cards display the suit, but not both the card's suit and card's value when dealt;"

As previously explained, when Applicant's cards are first dealt, the player knows the suit of the cards but does not know the card value. The player could then exchange cards.

By contrast, card suits and card values ALWAYS appear together on the same side of the cards in Stanton. Any other interpretation of Stanton is simply incorrect.

Stanton's card backs are very different than Applicant's; they give no indication whatsoever of the card's rank (i.e. the card's value) or its suit. This point is made clear as stated in Stanton's 1st Claim: "Playing cards as described ... will enable anyone without previous knowledge of cards, to deal these cards quickly and accurately into four groups or sets of equal value without knowing or seeing the faces of any card."

[emphasis added]. If, in fact, Stanton's card back provided the suit on the back side, this statement could not be true.

Hoyt, as explained above adds nothing to these references and even if they were combined they would not yield the applicant's inventions. (Hafezi Dec. ¶¶ 9 and 12).

Claims 13 and 19

Examiner states that "Needler teaches cards that display a suit on one side (e.g., clubs) and both a suit and value on the other side." As Applicant has explained above, Needler does not teach a suit on one side, provides no information relevant to any card game, and is only "the ornamental design for a card." Needler's cards are conventional cards with a club shaped design on the card back.

Therefore, combining Needler and Moody would only yield Moody.

Combining these references would not yield the Applicant's invention because two claim elements of Claim 13 are completely missing:

"[a] when the cards are dealt the card's suit is displayed, but the card's value is not displayed; [and]

[b] when a player selects a card both the card's value and the card's suit are displayed."

The resulting combination would also be missing the following claim elements of claim 19:

"(b) having the cards display the suit, but not the card value when dealt; [and]

(d) after the player selects each card, displaying both the card value and suit of the card[.]”

Thus, the resulting combination of these references would not yield the claimed inventions. (Hafezi Dec. ¶¶ 7 and 12).

Claim 18

Examiner states “Moody discloses an Electronic Video Poker Game, which deals multiple rows.” However, Moody does not disclose a game where more than five cards are dealt at one time. Instead, Moody repeats identical five-card hands multiple times. In Moody’s game, the cards are “duplicated” from one hand to another. (See col. 1, lines 22-24). They are not additional cards dealt from the deck, nor does the player select from more than five cards to build a five card hand as in Applicant’s Claim 18. Lastly, Moody does not disclose cards where the suit alone is displayed.

As explained above Needler does not disclose anything resembling the claimed inventions. Therefore, combining Needler and Moody does not result in the claimed invention of Claim 19. (Hafezi Dec. ¶¶ 7 and 12 - 13).

Claim 20

Applicant’s arguments with respect to Needler and Hoyt as mentioned above apply to Claim 20 as well.

Moreover, the Examiner’s statement that Needler “fail[s] to explicitly teach cards with a non-descriptive back” is not true. The backs of Needler are ornamental (as required by the design patent statute) -- and provide no information

whatsoever about the card's suit or the card's value. Simply put, Needler's card backs are non-descriptive. (Hafezi Dec. ¶ 7).

The combination of Needler, Hoyt and Moody does not have the following claim elements (see Hafezi Dec. ¶¶ 7 and 12-13):

“(b) having the cards display the suit, but not the card value
when dealt; [and]

(d) after the player selects each card, displaying both the card
value and suit of the card[.]”

Thus, the resulting combination is not the claimed invention and the obviousness rejection is improper. MPEP § 2143.03.

Claim 21 - Section 35 USC § 103

Examiner cites Needler and states “It would be obvious to deal cards in whatever shape that is desired since shape would constitute a design issue. Additionally, the dealing of cards in various shapes is well known in the art (e.g. in the game of *Memory* cards are dealt in the shape of a square, in the game of *Solitaire*, cards are ultimately dealt in the shape of a triangle.”

Needler has nothing to do with how cards are dealt, played, or arranged. Moreover, the arrangement of cards can be critical to how a game is played.

The Examiner's conclusion is based on the faulty premise, as explained above, that Needler discloses cards that when first dealt have the suit alone. As explained above this is incorrect, and Claim 21 cannot be obvious in view of Needler. (Hafezi Dec. ¶¶ 7 and 12-13)

Claims 4 and 22 - 25 - Allowable Subject Matter

The Examiner indicated that claims 4 and 22 to 25 would be allowable if rewritten in independent form. To address that objection, Applicant has rewritten claim 22 to be independent. No additional fee is required.

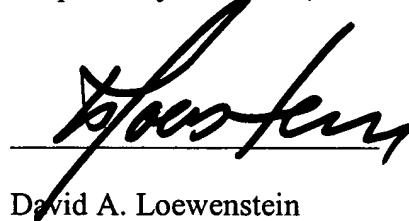
For reasons previously explained the underlying independent claims relating to claims 4 and 23 to 25 are allowable and the associated dependent claims are as well. Applicant, therefore, respectfully requests the Examiner to allow these claims in their present format.

CONCLUSION

For the foregoing reasons, Applicant believes that the claims are all in allowable format and respectfully requests the Examiner to issue a Notice of Allowance.

Dated: 8/31/04

Respectfully submitted,

A handwritten signature in black ink, appearing to read "D. Loewenstein", written over a horizontal line.

David A. Loewenstein
Reg. No. 35, 591
802 King Street
Rye Brook, NY 10573
(914) 937-4119